



AP/FPW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

IN RE APPLN. OF: SCHMIEDING et al.

SERIAL NO.: 10/635,174

FILED: August 6, 2003

FOR: USB TYPE PLUG CONNECTOR

GROUP: 2833 Confirmation No. 9171

EXAMINER: Hammond, Brigitte R. DOCKET: PRINZ H1797

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

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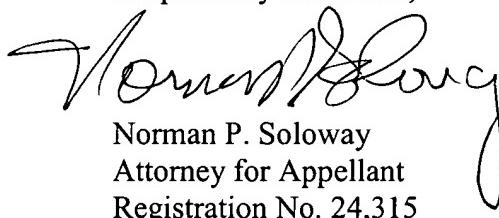
TRANSMITTAL LETTER

Dear Sir:

In connection with the above-entitled matter, enclosed please find the following:
Appellants' Reply Brief (10 pages).

In the event there are any fee deficiencies or additional fees are payable, please charge them (or credit any overpayment) to our Deposit Account No. 08-1391.

Respectfully submitted,


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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: MAIL STOP APPEAL BRIEF - PATENTS, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on JUNE 6, 2006, at Tucson, Arizona.

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APPELLANTS' REPLY BRIEF

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Serial No. 10/635,174
Docket No. PRINZ H1797
APPELLANTS' REPLY BRIEF

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APPELLANTS' REPLY BRIEF UNDER 37 CFR 1.193 (b)

This reply Brief is being filed in response to new points of argument raised in the Examiner's Answer mailed April 10, 2006. Appellants respond to these new points of argument as follows.

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STATUS OF CLAIMS

Claims 2-11 are pending in this Application.

Claim 1 has been cancelled.

Claims 2, 8, 10 and 11 stand finally rejected and are on Appeal.

Claim 9 has been allowed.

Claims 3-7 have been objected to as being dependent on a rejected base claim. But have been indicated to be allowable if rewritten in independent form.

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GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- I. WHETHER THE REJECTION OF CLAIMS 2, 8 AND 10 UNDER 35 U.S.C. 103(a) AS BEING UNPATENTABLE OVER YI 6,296,534 IN VIEW OF SHIU 5,961,350¹ IS PROPER; AND
- II. WHETHER THE REJECTION OF CLAIM 11 UNDER 35 U.S.C. 103(a) AS BEING UNPATENTABLE OVER YI AND SHIU AS APPLIED TO CLAIM 2, AND FURTHER IN VIEW OF CAPPER ET AL. 5,513,075 IS PROPER.

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¹ The Examiner refers to Shiu as U.S. Patent No. 5,961,351; however, the correct No. is 5,961,350.

ARGUMENTS

I. THE REJECTION OF CLAIMS 2, 8 AND 10 UNDER 35 U.S.C. 103(a) AS BEING UNPATENTABLE OVER YI 6,296,534 IN VIEW OF SHIU 5,961,350 IS IN ERROR.

Appellants' claims 2 and 10 both recite a housing with an accommodation chamber.

The Examiner takes the position that Yi teaches a housing that "has to have a chamber that accommodates the support plate 16 and contacts" (Examiner's Answer at page 6, lines 5-7). Yet, the Examiner admits and the Appellants agree that Yi does not explicitly teach a housing which includes an accommodation chamber. The Examiner, however, argues that the housing of Yi must, (implicitly), have a chamber that accommodates the support plate 16 and the contacts: "Yi discloses a housing as shown in fig. 8 by the dotted lines 30, (see col. 4, lines 58-64)," (Examiner's Answer at page 6 lines 4-5).

The referenced lines of Yi are:

"...referring to Fig. 8, the connecting portions 122, 142 and the adapter plate 16 are jointly enclosed within a non-conductive material by way of injection molding. The dimensions of the non-conductive material are indicated by a dotted line 30 in FIG. 8. Thus encapsulation of the adapter assembly 1 of the present invention is completed."

Dotted line 30 of FIG. 8, in combination with this passage, suggests the housing of Yi, which encapsulates the adapter assembly, is entirely filled by a combination of the adapter assembly and the non-conductive injection molding material. There is no cavity within Yi's housing, and, based on the disclosure, it is not reasonable to believe that Yi considers leaving a cavity or

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chamber of any sort within the housing. Therefore, the Examiner's position, presumably, is that any housing by definition implicitly has a chamber. This position is meritless.

Appellants' specification at page 3 describes the accommodation chamber within which an assembly unit can be installed. The housing of Yi, leaves no room, no cavity, no chamber within which an assembly unit can be installed or otherwise manipulated. Thus, Appellants' accommodation chamber has purpose, value, and utility that is independently definable and narrows the claim in a manner that is greater than being an implicit byproduct of a housing.

The Examiner also acknowledges that "Yi does not disclose the couplings being USB couplings." However, the Examiner takes the position that "Shiu discloses that two USB couplings being mounted on a support plate 12 is well known in the art. It would have been obvious to one of ordinary skill to modify the connector of Yi by having two USB couplings 20, 22 mounted on a support plate as taught by Shiu for accommodating two USB type plug connectors" (Examiner's Answer at page 4, lines 11-15, mailed April 10, 2006).

Appellants submit that there is no motivation to combine primary reference, Yi, with Shiu simply because the latter reference discloses that the feature of USB couplings is well known in the art. The Federal Circuit has stated that if a proposed modification to a prior art invention makes it unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed Cir. 1984). See also MPEP 2143.01. As disclosed in Yi, "an electrical adapter is required to electrically connect two connectors which have different standards." Yi teaches an electrical adapter. Replacing the two couplings of Yi with two USB couplings would make Yi unsatisfactory and inoperable as an electrical adapter.

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In order for a combination of prior art, to render prima facie obvious Appellants' claimed invention: (1) the asserted combination of prior art must provide all of the limitations of Applicant's claimed invention; and (2) the asserted prior art must provide some motivation to one skilled in the art to selectively combine them so as to achieve the claimed invention. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). For reasons that are stated in detail above, the Appellants respectfully submits that neither Yi nor Shiu in this case, whether taken singly or in combination can be said to satisfy either prong of the test presented above.

Accordingly, the rejection of claims 2 and 10 under 35 USC 103(a) as being unpatentable over Yi in view of Shiu is in error. Claim 8 depends directly on claim 2, and is allowable for the same reasons as stated above, as well as for its own additional limitations.

II. THE REJECTION OF CLAIM 11 UNDER 35 U.S.C. 103(a) AS BEING UNPATENTABLE OVER YI AND SHIU AS APPLIED TO CLAIM 2, AND FURTHER IN VIEW OF CAPPER ET AL. 5,513,075 IS IN ERROR.

Capper has been cited as teaching a connector having a mounting flange to a flat surface (Examiner's Answer at page 8, lines 6-7), and is acknowledged as so teaching. However, claim 11 depends directly on claim 2. The deficiencies of Yi and Shiu, vis-à-vis Appellants' claim 2, are discussed above. Capper does not provide the missing teachings to Yi and Shiu. A discussion of the features of the plug connector of Capper as it relates to the plug connector defined in Appellants' claim 8 does not address the deficiencies of Yi and Shiu, vis-à-vis Appellants' claim 2. Thus no combination of Yi, Shiu, and Capper can achieve nor render obvious claim 11, and the rejection of claim 11 as obvious from Yi and Shiu and further view of Capper likewise is in error.

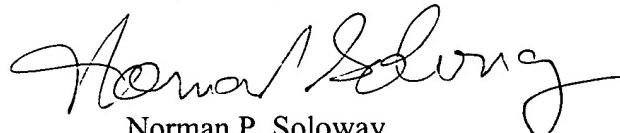
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CONCLUSION

In view of the foregoing, it is respectfully requested that the Examiner's Rejection of the subject Application be reversed in all respects.

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